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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,952	08/07/2003	Norishige Morimoto	JP920020098US1	1220
67158 7590 11/30/2007 SHIMOKAJI & ASSOCIATES, P.C. 8911 RESEARCH DRIVE IRVINE, CA 92618			EXAMINER PEARSON, DAVID J	
			ART UNIT 2137	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/635,952

Applicant(s)

MORIMOTO ET AL.

Examiner

David J. Pearson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,9 and 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. Claims 1, 9, 11, 16 and 18-21 have been amended. Claims 5-8 and 10 have been canceled. Claims 1-4, 9 and 11-21 have been examined.

Claim Objections

2. Claims 16-18 objected to because of the following informalities:

Claims 16 and 18 have a period in the middle of the claim. Claim 17 inherits the deficiency of the claim is depends on.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 9 and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Patent Application Publication 2003/0009669), and further in view of Ratnakar (U.S. Patent 6,522,766).

For claim 1, White et al. teaches a contents server distributing digital contents via a network in response to an acquisition request from outside, said contents server comprising:

A contents storage part for storing a plurality of digital contents wherein a different digital watermark is embedded (note paragraph [0028]); and

an information adding part **comprising:**

i) a content selector for inputting digital watermark embedded digital contents Ce0 and Ce1, and selectively switching and outputting the digital contents (note paragraph [0030]), and

ii) controlling said content selector to output a partial set of contents Ce0(n) of contents Ce0 and a partial set of contents Ce1(n) of content Ce1 to generate digital watermark content Cf (note paragraph [0047]);

for synthesizing said digital contents for each specific **acquisition requestor**, adding to said digital contents information specified by a digital watermark **that is different for each acquisition requestor** being embedded for each part of said digital contents (note paragraph [0047]).

White et al. fail to teach:

a pseudo random number generator for controlling said content selector.

Ratnakar teaches:

a pseudo random number generator for controlling said content selector
(note column 5, lines 29-32 and 36-39).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the watermarking of White et al. and the pseudo random number generator for controlling a content selector of Ratnakar. One of ordinary skill in the art

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at the time of the invention would have motivated to combine White et al. and Ratnakar because it would enhance the resistance of embedded information to unauthorized removal (note column 3, lines 61-65 of Ratnakar).

For claim 2, the combination of White et al. and Ratnakar teaches claim 1, wherein said information adding part dynamically adds said information to said digital contents in response to an acquisition request for predetermined digital contents (note paragraph [0030] of White et al.).

For claim 3, the combination of White et al. and Ratnakar teaches claim 1, wherein said information adding part forms a bit row with a digital watermark-embedded for each part of said digital contents and describes said information in said digital contents with said bit row (note paragraph [0028] of White et al.).

For claim 4, the combination of White et al. and Ratnakar teaches claim 1, wherein said contents storage part stores said digital contents compressed in a predetermined compression format (note paragraph [0025] of White et al.), and said information adding part for, by synthesizing a plurality of said digital contents based on the codeword sequence offset information regarding said digital contents in accordance with said compression format, adding said information without unpacking said digital contents (note paragraph [0058] of White et al.).

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For claim 9, the combination of White et al. and Ratnakar teaches a network system comprising a server distributing digital contents via a network, and a client terminal receiving said distributed digital contents wherein:

said client terminal transmits an acquisition request for desired digital contents to said server (note paragraph [0030] of White et al.); and

said server said comprising:

a contents storage part for storing a plurality of digital contents wherein a different digital watermark is embedded (note paragraph [0028] of White et al.); and an information adding part **comprising:**

i) a content selector for inputting digital watermark embedded digital contents Ce0 and Ce1, and selectively switching and outputting the digital contents (note paragraph [0030] of White et al.), and

ii) a pseudo random number generator for controlling said content selector (note column 5, lines 29-32 and 36-39 of Ratnakar) **to output a partial set of contents Ce0(n) of contents Ce0 and a partial set of contents Ce1(n) of content Ce1 to generate digital watermark content Cf** (note paragraph [0047] of White et al.);

said server synthesizing said digital contents for each specific client terminal, adding to said digital contents information specified by a digital watermark, by switching and synthesizing for each specific client terminal a plurality of digital contents wherein a different watermark is embedded, generates digital contents wherein a predetermined information responding to said acquisition request is

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embedded and transmits said digital contents to said client terminal (note paragraph [0047] of White et al.).

For claim 11, the combination of White et al. and Ratnakar teaches a computer comprising:

a selector for inputting a plurality of digital contents wherein a different digital watermark is embedded, and for outputting while switching selectively said plurality of digital contents for each specific part (note paragraph [0047] of White et al.);

an information adding part comprising:

i) a content selector for inputting digital watermark embedded digital contents Ce0 and Ce1, and selectively switching and outputting the digital contents (note paragraph [0030] of White et al.), and

ii) a pseudo random number generator for controlling said content selector (note column 5, lines 29-32 and 36-39 of Ratnakar) to output a partial set of contents Ce0(n) of contents Ce0 and a partial set of contents Ce1(n) of content Ce1 to generate digital watermark content Cf (note paragraph [0047] of White et al.);

for synthesizing said digital contents for each specific acquisition requester, adding to said digital contents information specified by a digital watermark that is different for each acquisition requester being embedded for each part of said digital contents (note paragraph [0047] of White et al.); and

a control part for controlling said selector based on a predetermined embedment information, said computer generating by a control at said control part (note paragraph [0047] of White et al.), wherein said embedment information is described with a bit row being formed by said digital watermark-embedded in each of said part of said digital contents (note paragraph [0028] of White et al.).

For claim 12, the combination of White et al. and Ratnakar teaches claim 11, wherein said selector inputs a plurality of digital contents where a digital watermark representing the bit information 0 is embedded, and a plurality of digital contents where a digital watermark representing the bit information 1 is embedded (note paragraph [0028] of White et al.), and selects digital contents where a digital watermark corresponding to desired bit information is embedded under a control of said control part (note paragraph [0047] of White et al.).

For claim 13, the combination of White et al. and Ratnakar teaches claim 11, wherein said selector inputs to said selector digital contents where a digital watermark representing the bit information 0 is embedded, digital contents where a digital watermark representing the bit information 1 is embedded, and digital contents where a digital watermark is not embedded (note paragraph [0028] of White et al.), and selects said digital contents under a control of said control part whereby a portion containing no bit information is set in said bit row describing said embedment information (note paragraph [0047] of White et al.).

For claim 14, the combination of White et al. and Ratnakar teaches claim 11, wherein said selector selectively switches said digital contents, based on the pointer information pointing to a delimiter for said part of said digital contents (note paragraph [0047] of White et al.).

For claim 15, the combination of White et al. and Ratnakar teaches claim 14, wherein said selector inputs said digital contents compressed in a predetermined compression format (note paragraph [0025] of White et al.), and selectively switches said digital content, using the codeword sequence offset information regarding said digital contents in accordance with said compression format as said pointer information (note paragraph [0058] of White et al.).

For claim 16, the combination of White et al. and Ratnakar teaches a method for adding information to digital contents by using a computer, said method comprising;

a first step of generating a plurality of digital watermark-embedded contents by embedding a different digital watermark in predetermined digital contents, and of storing generated digital contents to a predetermined storage device (note paragraph [0028] of White et al.); and

a second step of, by reading out from said storage device a plurality of digital contents where a different digital watermark is embedded and switching and synthesizing said digital contents for each specific part, adding to said digital contents

information specified by a digital watermark being embedded in each part of said digital contents (note paragraph [0047] of White et al.);

an information adding part **comprising:**

i) a content selector for inputting digital watermark embedded digital contents Ce0 and Ce1, and selectively switching and outputting the digital contents (note paragraph [0030] of White et al.), and

ii) a pseudo random number generator for controlling said content selector (note column 5, lines 29-32 and 36-39 of Ratnakar) to output a partial set of contents Ce0(n) of contents Ce0 and a partial set of contents Ce1(n) of content Ce1 to generate digital watermark content Cf (note paragraph [0047] of White et al.);

for synthesizing said digital contents for each specific acquisition requester, adding to said digital contents information specified by a digital watermark that is different for each acquisition requester being embedded for each part of said digital contents (note paragraph [0047] of White et al.).

For claim 17, the combination of White et al. and Ratnakar teaches claim 16, wherein said first step comprises compressing said generated digital contents, creating the pointer information pointing to a delimiter position in the part of said compressed digital contents (note paragraph [0025] of White et al.), and storing it in said storage device, and said second step comprises reading out said pointer information from said storage device, synthesizing said digital contents based on said pointer information, and

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adding said information without unpacking the digital contents (note paragraph [0058] of White et al.).

For claim 18, the combination of White et al. and Ratnakar teaches a program **product comprising a medium having computer readable code stored thereon** for causing a computer to perform the data processing by controlling a computer, comprising:

a first process for reading out predetermined embedment information from a predetermined storage device (note paragraph [0028] of White et al.); and

a second process for acquiring a plurality of digital contents where a different digital watermark is embedded, selectively switching said plurality of digital contents for a specific part, based on said embedment information, and generating the digital contents describing said embedment information, using a bit sequence formed with a digital watermark-embedded in said part of said digital contents (note paragraph [0047] of White et al.);

an information adding part **comprising:**

i) **a content selector for inputting digital watermark embedded digital contents Ce0 and Ce1, and selectively switching and outputting the digital contents** (note paragraph [0030] of White et al.), and

ii) **a pseudo random number generator for controlling said content selector** (note column 5, lines 29-32 and 36-39 of Ratnakar) **to output a partial set of contents Ce0(n) of contents Ce0 and a partial set of contents Ce1(n)**

of content Ce1 to generate digital watermark content Cf (note paragraph

[0047] of White et al.);

for synthesizing said digital contents for each specific acquisition requester, adding to said digital contents information specified by a digital watermark that is different for each acquisition requester being embedded for each part of said digital contents (note paragraph [0047] of White et al.).

For claim 19, the combination of White et al. and Ratnakar teaches claim 18, wherein said second process of said program performed by said computer comprises acquiring a plurality of digital contents where a digital watermark representing the bit information 0 is embedded, and a plurality of digital contents where a digital watermark representing the bit information 1 is embedded (note paragraph [0028] of White et al.), and selecting digital contents where a digital watermark corresponding to appropriate bit information describing said embedment information is embedded (note paragraph [0047] of White et al.).

For claim 20, the combination of White et al. and Ratnakar teaches claim 18, wherein said second process of said program performed by said computer comprises acquiring digital contents where a digital watermark representing the bit information 0 is embedded, digital contents where a digital watermark representing the bit information 1 is embedded, and digital contents where a digital watermark is not embedded (note paragraph [0028] of White et al.), and generating digital contents describing said

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embedding information, using said bit sequence with said digital watermark where a portion containing no bit information is set (note paragraph [0047] of White et al.).

For claim 21, the combination of White et al. and Ratnakar teaches claim 18, wherein said second process of said program performed by said computer comprises acquiring said digital contents compressed in a predetermined compression format (note paragraph [0025] of White et al.), and selecting said digital contents, based on the codeword sequence offset information regarding said digital contents in accordance with said compression format (note paragraph [0058] of White et al.).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

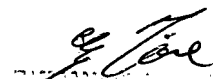
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Pearson whose telephone number is (571) 272-0711. The examiner can normally be reached on Monday - Friday, 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DJP


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